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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,904	11/01/1999	SCOT ADAMS WEBB	839-636	7932

7590 10/23/2002

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EXAMINER

PEREZ, GUILLERMO

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/430,904

Applicant(s)

WEBB ET AL.

Examiner

Guillermo Perez

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 4-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostwald (U. S. Pat. No. 3,693,035) in view of Duffy et al. (U. S. Pat. No. 5,221,170) and further in view of H. C. Weidner, Jr. (U. S. Pat. Re. 27,085).

Ostwald discloses a dynamoelectric machine comprising a seal casing (18) and an end-shield (13), wherein the seal casing (18) and the end-shield (13) are secured by a plurality of electrically insulated bolts (14), each bolt having a head with a flange and a threaded shank, with some portion of the threaded shank and the underside of the flange having an electrically insulating material (22, 23).

However, Ostwald does not disclose that the electrically insulating material is an epoxy powder composition coating applied thereto. Ostwald does not disclose that the coating remains functional with the plurality of bolts fully tightened and at an electrical potential of 2500 VDC. Ostwald does not disclose that the coating has a thickness of about 0.004 to about 0.014 in. Ostwald does not disclose that the electrically insulating material extends to a location substantially midway along the threaded shank.

Duffy et al. disclose an electrically insulating epoxy powder composition coating (column 6, lines 67-68 and column 7, lines 1-9) applied thereto. Duffy et al. disclose that

the coating remains functional with the plurality of bolts (figure 21) fully tightened (column 4, lines 1-4). The invention of Duffy have the purpose of improving definition of the resin type material which is applied over a desired arcuate and vertical areas of the threads of the bolt.

H. C. Weidner, Jr. disclose that the electrically insulating material (22s) extends to a location substantially midway along the threaded shank (10b in figure 3). H. C. Weidner, Jr.'s invention has the purpose of sealing the aligned holes of the different stacked pieces.

It would have been obvious at the time the invention was made to modify the dynamoelectric machine of Ostwald and provide it with the electrically insulating epoxy powder composition coating and configuration disclosed by Duffy et al. and H. C. Weidner, Jr. for the purpose of improving definition of the resin type material which is applied over a desired arcuate and vertical areas of the threads of the bolt.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the coating with a thickness of about 0.004 to about 0.014 in. since it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to keep the coating functional when fully tightened at an electrical potential of 2500 VDC since it has been held that discovering an optimum value of a

result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

Applicant's arguments with respect to claims 4-5 and 7 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's remark that Oswald utilizes no fewer than four separate parts, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U. S. 164 (1893).

In response to Applicant's remark that the threaded weld disclosed in Duffy does not incorporate an integral radial flange, it must be noted that the integral flange is shown in figure 21. It has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U. S. 164 (1893). The same concept applies to Weidner.

In response to Applicant's remark that Weidner does not show a continuous coating between the flange and the threaded shank, it must be noted that figures 2 and 3 of Weidner disclose a continuous coating (22) ("*to cover or spread with a finishing, protecting, or enclosing layer*"; Merriam-Webster's Collegiate Dictionary Tenth Edition) between the underside of the flange (21) ("*a rib or rim for strength, for guiding, or for attachment to another object*"; Merriam-Webster's Collegiate Dictionary Tenth Edition) and the threaded shank (10b and column 2, lines 35-43).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

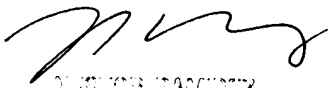
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guillermo Perez whose telephone number is (703) 306-

5443. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308 1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305 3432 for regular communications and (703) 305 3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.

Guillermo Perez
October 17, 2002



NESTOR RAMIREZ
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